

REMARKS

Upon entry of the above amendments, claims 4, 5, 9-15, 31-34, 43, 44, 47-50, 54, and 98-128 will be pending. Applicants reserve the right to pursue subject matter that will no longer be pending after the amendment above, or which has not yet been pursued, in a related application. The claim amendments add no new matter as there is basis in the specification throughout and in the claims as filed. For example, basis for the new claims is in the specification on page 14, lines 21-25, and page 15, lines 17-19. Thus, entry of the amendments is proper. Applicants respectfully request reconsideration of the pending claims.

Information Disclosure Statement

Applicants thank the Examiner for reviewing the Information Disclosure Statements filed 6 February 2004 and 20 April 2004. A new Supplemental Information Disclosure Statement accompanies this Amendment for the Examiner's review.

Rejection for alleged anticipation

The office rejected claims 4, 5, 9-15, 31, 43, 44, 47-50, and 109-125 under 35 USC §102(b) as allegedly anticipated by Campbell et al. (WO 98/35609). The Examiner cites to the January 29, 2004 Office Action as stating the reasons for this rejection. The Examiner stated that the remarks presented in the response to that Office Action were not persuasive because the claims recite "a method of producing a database **comprising**: selecting only healthy members of a population of organisms not manifesting any disease state," and that the claims "do not exclude the fact that a database could contain both healthy population data, as well as disease population data in subsets, as disclosed in Campbell et al." The Examiner states that the population used for the database in Campbell et al. "consists of two subpopulations, those having acquired a specified biological condition and those not having acquired the specified biological condition," (citing the Abstract). The presently pending claims 4, 5, 9-15, 31, 43, 44, 47-50, and 109-125, include methods and systems related to a healthy database that includes data from only healthy members of a population of organisms not manifesting any disease state;

the members are not pre-selected on the basis of sharing a common disease. Thus, the present claims do not refer to a database consisting of two subpopulations, as disclosed by Campbell et al. As Campbell et al. do not teach or suggest the methods and systems of the present claims, Applicants respectfully request that the rejection under §102(b) be withdrawn.

In addition, new claims 126-128 incorporate the term “consisting essentially of” instead of the term “comprising.” Support for this term may be found in the specification at, for example, page 14, line 4 to page 15, line 19.

Rejection for alleged obviousness

The Examiner restated the rejection of claims 32-34, 99, 100, and 102 under 35 USC §103(a) as being allegedly unpatentable over EP 0596205 A2 (Bullaughay et al.), in view of Campbell et al., in further view of U.S. 5,498,545 (Vestal). Applicants respectfully submit that the combination of these references does not result in the presently claimed subject matter. As stated above, Campbell does not teach or suggest methods or systems related to a healthy database, that includes data from only healthy members of a population of organisms not manifesting any disease state and where the members are not pre-selected on the basis of sharing a common disease. Bullaughay, relating to an analytical system that coordinates the operations of various hardware instruments in carrying out a lab bench method and communicating with a number of instrument applications or programs, and Vestal, which relates to a system for analyzing multiple samples by MALDI-MS, do not cure these defects. Therefore, Applicants respectfully submit that claims 32-34, 99, 100, and 102 are not *prima facie obvious* over the cited references.

The Examiner restated the rejection of claims 54 and 101 under 35 USC §103(a) as being allegedly unpatentable over Bullaughay et al., in view of Campbell et al. As discussed above, Bullaughay does not cure Campbell's failure to teach or suggest methods or systems related to a healthy database, that includes data from only healthy members of a population of organisms not manifesting any disease state and where the members are not pre-selected on the basis of sharing a common disease. Therefore, Applicants respectfully submit that claims 54 and 101 are not *prima facie obvious* over the cited references.

The Examiner restated the rejection of claim 98 under 35 USC §103(a) as being allegedly unpatentable over Campbell et al. in view of Vestal. As discussed above, Vestal does not cure Campbell's failure to teach or suggest methods or systems related to a healthy database, as the healthy database includes data from only healthy members of a population of organisms not manifesting any disease state and where the members are not pre-selected on the basis of sharing a common disease. Therefore, Applicants respectfully submit that claim 98 is not *prima facie obvious* over the cited references

The Examiner restated the rejection of claims 103-108 under 35 USC §103(a) as being allegedly unpatentable over Bullaughey et al., in view of Campbell et al., in view of Vestal, in further view of U.S. 6,602,662 (Koster et al.). As discussed above, Bullaughey and Vestal do not cure Campbell's failure to teach or suggest methods or systems related to a healthy database, that includes data from only healthy members of a population of organisms not manifesting any disease state and where the members are not pre-selected on the basis of sharing a common disease. Moreover, this defect is not cured in Koster, which relates to a mass spectrometer-based process for detecting a particular nucleic acid sequence in a biological sample. Therefore, Applicants respectfully submit that claims 103-108 are **not** *prima facie obvious* over the cited references

CONCLUSIONS

Applicants thank the Examiner for withdrawing the rejection of claims under 35 U.S.C. §101. Applicants respectfully submit that, after entry of the amendment above, all pending claims will be in condition for allowance, and they earnestly solicit an early notice to such effect. That said, should any issues or questions remain, the Examiner is encouraged to telephone the undersigned at (858) 623-9470 so that they may be promptly resolved.

In the unlikely event the transmittal letter is separated from this document and the Office determines that an extension and/or other relief is required, Applicants petition for any required relief, including extensions of time, and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to the credit card disclosed in form PTO-2038 filed with this document.

Respectfully submitted,

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By: _____

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